

Serial No. 10/730,095
OKI.629
Reply Brief dated July 28, 2010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of : Before the Board of Appeals
Kaoru Tsukamoto et al. : Appeal No.:
Serial No.: 10/730,095 : Group No.: 3715
Filed: December 9, 2003 : Examiner: Kang Hu
Conf. No.: 2690

For: KARAOKE SERVICE METHOD AND SYSTEM BY MOBILE DEVICE

REPLY BRIEF

U.S. Patent and Trademark Office
****Via efilng****
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Date: July 28, 2010

Sir:

In response to the Examiner's Answer dated **June 10, 2010**, Appellants hereby submit this Reply Brief.

Although Appellants generally reaffirm all of the arguments that were previously presented in the Appeal Brief dated May 3, 2010, for brevity Appellants here only specifically address the following responsive to the Examiner's Answer dated June 10, 2010.

Claims rejections - 35 U.S.C. 101

1) Throughout prosecution, the Examiner has relied upon the “machine-or-transformation test” to reject claims 20-25 under 35 U.S.C. 101 (i.e., see the Final Office Action dated November 2, 2009).

However, in *Bilski et al. v Kappos*, 561 U.S. _____ (2010) as recently decided, the Supreme Court of the United States held that the “machine-or-transformation test” is not the sole test for patent eligibility under §101. The Court held that it is unaware of any ordinary, contemporary, common meaning of “process” that would require it to be tied to a machine or the transformation of an article. The Examiner’s reliance upon the “machine-or-transformation test” in this case is thus improper.

Appellants respectfully submit that claims 20-25 are directed to a statutory subject matter eligible process, and do not fall within a judicial exception (law of nature, natural phenomena, or abstract idea). Accordingly, Appellants respectfully submit that claims 20-25 are in compliance with 35 U.S.C. 101, and respectfully request that this rejection be withdrawn for at least these reasons.

2) Even assuming *arguendo* that the “machine-or-transformation test” is a proper test for patent eligibility under §101 (which Appellants do not concede), the Examiner has misapplied the test with respect to claim 20.

On page 11, lines 10-12 of the Examiner’s Answer dated June 10, 2010, the

Examiner has stated the following:

"The present claim limitations provide recitation of memory, sound generator and multimedia processor and do not provide and correlate each of the components to the mobile device."

The Examiner has apparently asserted that the method steps are not critically tied to the mobile device, because the mobile device has not been positively recited in the body of the claim. Appellants respectfully submit that it should be readily clear that the memory, sound generator and multimedia processor as featured in claim 20 are part of the mobile device. Despite this unduly narrow view as taken by the Examiner, the karaoke service method of claim 20 is featured as using a multimedia processor, using a sound generator, and using a memory, each of which are a machine or parts thereof. Thus, contrary to the Examiner's assertion, the karaoke service method of claim 20 is critically tied to a machine.

3) On page 12, lines 2-6 of the Examiner's Answer dated June 10, 2010, the Examiner has asserted the following:

"...the recitation of multimedia processor in the claim merely states that the multimedia processor is used in the performance of the step, but does not recite how this use occurs, and therefore does not provide a critical tie to a machine actually performing the process..."

However, claim 20 features that the karaoke events are executed, and the manner in which they are executed by the multimedia processor is recited as *"in accordance with the karaoke event data in time order in synchronization responsive to generation of the interrupt signal"*. Thus, contrary to the Examiner's assertion, it should be readily clear that claim 20 does recite how the multimedia processor is used during executing of the karaoke events. It would appear that the Examiner has misconstrued claim 20.

Claims rejections – 35 U.S.C. 102

4) In the first full paragraph on page 13 of the Examiner's Answer dated June 10, 2010, the Examiner has asserted that paragraphs [0005] and [0048]-[0050] of the Naples et al. reference (U.S. 2002/0162445) disclose song data having synchronization data embedded therein.

However, paragraphs [0005] and [0048]-[0050] of the Naples et al. reference do not specifically describe synchronization data embedded in song data. Appellants concede that the Naples et al. reference describes MIDI streams that provide information about how content is to be synthesized. However, synchronization data is not specifically disclosed or identified in the MIDI stream.

If it is the Examiner's position or understanding that such a MIDI stream as very generally described in paragraph [0005] of the Naples et al. reference inherently

includes synchronization data as specifically embedded in song data, the Examiner is requested to establish a particular teaching or showing of synchronization data embedded within song data of a MIDI stream as evidence thereof, and to also establish how such synchronization data embedded in song data of a MIDI stream is used in the Naples et al. reference to provide an interrupt signal.

5) On page 13, lines 19-20 of the Examiner's Answer dated June 10, 2010, the Examiner has asserted the following:

"clear distinction can also be found in ¶ 6 of Naples, where Naples provides the difference between audio streams with and without such synchronization data as claimed."

However, paragraph [0006] of the Naples et al. reference merely describes that MP3 streams, unlike MIDI streams, contain actual sound recordings of audio content and that the MP3 files can quite often be played back on a modern multimedia personal computer with a minimal amount of specialized hardware. Contrary to the Examiner's assertion, paragraph [0006] of the Naples et al. reference does not disclose or even remotely suggest "the difference between audio streams with and without such synchronization data" as asserted by the Examiner. The Examiner has apparently misconstrued the Naples et al. reference.

6) On page 14, lines 9-12 of the Examiner's Answer dated June 10, 2010, the Examiner has asserted the following:

"Contrary to the argument provided by the appellant, the 'synchronization timing' as specified by the appellant is nothing more than synthesizer control data as provided by Naples allowing the system to manage synchronous playback of the audio contents".

However, the Examiner has not clearly and specifically identified the above noted "synthesizer control data" in the Naples et al. reference. That is, the Examiner has not clearly identified in the Naples et al. reference synthesizer control data that is derived from synchronization data embedded in song data, and that is used by a sound generator to provide an interrupt signal. In particular, paragraph [0196] of the Naples et al. reference describes performance timer interface 84 in Fig. 14A that allows the exchange of timing signals, in particular the exchange or dissemination of a clock pulse between objects that implement the performance timer interface 84. It would thus appear that a generated clock signal is used in the Naples et al. reference to provide synchronization timing, not synchronization data embedded within song data.

7) On page 15, lines 8-12 of the Examiner's Answer dated June 10, 2010, the Examiner has asserted the following:

"The system logic interrupts the MIDI contents according to different

timing information and provides synchronized audio-visual signals (interrupt signal) to the processor of when each audio track of the multi-track stream is to be played or when visual representations are presented to the user. Naples further provides detailed hardware information in ¶ 111 – 118 and software architecture information in ¶ 119 – 127.”

The Examiner has further made reference to paragraphs 54-63 in this regard.

However, paragraphs [0054]-[0063], [0111]-[0118] and [0119]-[0127] of the Naples et al. reference do not specifically describe a “synchronized audio-visual signal (interrupt signal)” as asserted by the Examiner.

Conclusion

For all the foregoing reasons, Appellants respectfully submit that claims 6-12 and 20-25 are patentable over the cited prior art. Therefore, Appellants respectfully request that claims 6-12 and 20-25 be allowed and that this application be passed to issue.

In the event that there are any outstanding matters remaining in the present application, please contact Andrew J. Telesz, Jr. (Reg. No. 33,581) at (571) 283-0720 in the Washington, D.C. area, to discuss these matters.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment for any additional fees that may be required under 37 C.F.R. 41.20 or 37 C.F.R. 1.17 and 1.136(a), or credit any overpayment, to Deposit Account No. 50-0238.

Respectfully submitted,

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